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10/821,121	04/08/2004	Jeffrey B. Levering	N0389.70009US01	8205

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EXAMINER

BIBBEE, JARED M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,121	Applicant(s) LEVERING ET AL.	
	Examiner JARED M. BIBBEE	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,18,20-29,35,37-46,52-54,56,57,59,61,62,64,66,67 and 69-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,3-12,18,20-29,35,37-46,52-54,56,57,59,61,62,64,66,67 and 69-75.

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DETAILED ACTION

Response to Amendment

1. This Office Action has been issued in response to amendment filed on 29 September 2008. Claims 2, 13-17, 19, 30-34, 36, 47-51, 55, 58, 60, 63, 65, and 68 are cancelled. Claims 70-75 are newly added. Claims 1, 3-12, 18, 20-29, 35, 37-46, 52-54, 56, 57, 59, 61, 62, 64, 66, 67, and 69-75 are pending. Applicants' arguments have been carefully and respectfully considered in light of the instant amendment and are not persuasive, as they relate to the claim rejections under 35 U.S.C. 103 as will be discussed below. Accordingly, this action has been made NON-FINAL.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/2008 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 3-12, 70, and 71 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The method is not (1) tied to another

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statutory class (such as a particular apparatus) nor does the method (2) transform underlying subject matter (such as an article or materials) to a different state or thing. As such, the process/method is not a patent eligible process under 35 USC § 101.

NOTE: Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 5 101 and should be rejected as being directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 3-12, 18, 20-29, 35, 37-46, 52-54, 56, 57, 59, 61, 62, 64, 66, 67, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burakoff et al (US 6,122,635) in view of Johnson (US 2002/0107847 A1).**

As to claim 1, Burakoff clearly teaches a computer-implemented method comprising acts of:

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- (A) executing a set of programmed instructions on a source file to identify a source location containing a particular data element within the source file (*see column 3, lines 15-28*), the programmed instructions employing at least one parameter relating to the data element's appearance within the source file to identify the source location (*see column 3, lines 46-49; Note that the start and end line markings are parameters that define the start of desired information and the end of desired information.*); and
- (B) storing an indication of the source location and a representation of the data element (*see column 3, lines 20-33*).

Burakoff does not appear to explicitly disclose:

- (C) presenting to a user the representation of the data element in a file other than the source file in a manner which visually informs the user that the data element may be retrieved at the source location;
- (D) receiving a request, from the user viewing the representation of the data element in the file other than the source file, to retrieve the data element at the source location; and
- (E) employing the indication of the source location to retrieve the data element at the source location.

However, Johnson teaches presenting to a user the representation of the data element in a file other than the source file in a manner which visually informs the user that the data element may be retrieved at the source location (*see [0040]; Note that within a web browser's search results (file other than the source file) Johnson creates hyperlinks to the actual source file. The*

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hyperlinks, which visually enhance the text (data element), are visual queues that signal to the user he/she may click on the link to retrieve the source file.).

Johnson also teaches receiving a request, from the user viewing the representation of the data element in the file other than the source file, to retrieve the data element at the source location *(see [0040]; Note that Figures 10-12 show various ways in which hyperlinks can be displayed. Johnson discloses receiving a query from a user and based on the query the system generates results with embedded hyperlinks to the actual source file. The user is able to click on the hyperlink in order to retrieve the full text (data element) from the source file.); and* employing the indication of the source location to retrieve the data element at the source location *(see [0040]; Note that Figures 10-12 show various ways in which hyperlinks can be displayed. Johnson discloses receiving a query from a user and based on the query the system generates results with embedded hyperlinks to the actual source file. The user is able to click on the hyperlink in order to retrieve the full text (data element) from the source file.).*

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Burakoff and Johnson before him or her, to modify the teachings of Burakoff to include the user request for data from a source location using hyperlinks of Johnson for the purpose of developing a search engine capable of returning a graphical representation of web sites *(see [0009])*.

Therefore, it would have been obvious to combine Johnson with Burakoff to obtain the invention as specified in the instant claims.

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As to claim 3, Burakoff clearly teaches the limitation of the parameter is provided in a data structure which is accessed by the software application (*see column 3, lines 31-37; Note that the file server is the data structure.*).

As to claim 4, Burakoff clearly teaches the limitation of at least one parameter identifies text which accompanies the data element within the source location (*see column 3, lines 46-49*).

As to claim 5, Burakoff clearly teaches the limitation of at least one parameter identifies text which represents the data element (*see column 3, lines 46-49*).

As to claim 6, Burakoff clearly teaches the limitation of the set of programmed instructions identifies the source location by preliminarily identifying the source location, requesting input from a user as to whether the source location is preliminarily identified correctly, and processing the input to identify the source location (*see column 7, lines 51-67 through column 8, lines 1-14*).

As to claim 7, Burakoff clearly teaches the limitation of the act of processing the input further comprises updating a characteristic of the data element (*see column 8, lines 9-11; Note that the system operator specifies the end number. The end number being a characteristic in that it defines where a item ends.*).

As to claim 8, Burakoff clearly teaches the limitation of the file comprises a plurality of characters including a first character (*see column 3, line 25; Note that the start line inherently has a first character.*), and the source location is identified by a number of characters from the first character (*see column 3, line 25-27; Note that the end line is a given number of characters away from the start line's first character.*).

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As to claim 9, Burakoff clearly teaches the limitation of the first character is at the beginning of the file (*see column 3, line 25; Note that the start line can be any line within the file and that includes the first line in the file.*).

As to claim 10, Burakoff clearly teaches the limitation of the data structure comprises a plurality of lines of information including a first line of information (*see column 3, line 25; Start Line*), and the source location is identified by a number of lines from the first line of information (*see column 3, line 25-27; Note that the end line specifies the number of lines from the start line is identified as desired text.*).

As to claim 11, Burakoff clearly teaches the limitation of the first line of information is at the beginning of the file (*see column 3, line 25; Note that the start line can be any line within the file and that includes the first line in the file.*).

As to claim 12, Burakoff clearly teaches the limitation of the data structure comprises a plurality of pixels arranged in a grid containing rows and columns (*see column 5, lines 28-31; Note that Burakoff discloses a general purpose computer for carrying out the invention. The computer comprises a display. It is inherent that the display is presenting the files to the user through computer screen and it is also inherent that the computer screen is made of rows and columns of pixels.*), and the source location is identified by a pixel found at an intersection of a row and a column (*Note that since the file is being presented using the display in order for the user to view the identified desired text, it is inherent that the starting line and ending line for the desired text would have a pixel location on the screen.*).

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As to claims 18 and 20-29, these claims are computer-readable medium claims corresponding to the method claims 1 and 3-12 respectively, and are rejected for the same reasons set forth in the rejection of claim 1 and 3-12 above.

As to claims 35 and 37-46, these claims are system claims corresponding to the method claims 1 and 3-12 respectively, and are rejected for the same reasons set forth in the rejection of claim 1 and 3-12 above.

With respect to independent claim 52, Burakoff teaches a method of accessing at least one data element stored at a source location, the method comprising acts of:

- (A) receiving a request from a user to access the at least one data element at the source location, the source location comprising at least a portion of a source file containing the at least one data element, the source location having been identified via an execution of a set of programmed instructions employing at least one parameter relating to the data element's appearance within the source file to identify the source location, the source file comprising a securities filing (*see column 1, lines 64-67 through column 2, lines 1-3 and column 3, lines 15-28; Note that the start and end line markings are parameters that define the start of desired information and the end of desired information.*);
 - (B) retrieving an indication of the source location from electronic file storage (*see column 2, lines 4-26*);
 - (C) processing the indication to access the source location (*see column 2, lines 27-37*);
- and

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- (D) presenting the at least one data element stored at the source location to the user (*see column 9, lines 30-40 and lines 51-53*).

Burakoff does not appear to explicitly disclose the request being received from a user viewing a representation of the data element in a file other than the source file.

However, Johnson teaches the request being received from a user viewing a representation of the data element in a file other than the source file (*see [0040]*; *Note that Figures 10-12 show various ways in which hyperlinks can be displayed. Johnson discloses receiving a query from a user and based on the query the system generates results with embedded hyperlinks to the actual source file. The user is able to click on the hyperlink in order to retrieve the full text (data element) from the source file.*).

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Burakoff and Johnson before him or her, to modify the teachings of Burakoff to include the user request for data from a source location using hyperlinks of Johnson for the purpose of developing a search engine capable of returning a graphical representation of web sites (*see [0009]*).

Therefore, it would have been obvious to combine Johnson with Burakoff to obtain the invention as specified in the instant claims.

The examiner is interpreting the computer-readable medium, according to applicant's specification, as non-volatile recording medium, floppy disk, flash memory, or any other suitable tangible medium. Burakoff clearly teaches the computer-readable medium in column 5, lines 39-50.

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As to claim 53, this claim is a computer-readable medium claim corresponding to the method claim 52 respectively, and is rejected for the same reasons set forth in the rejection of claim 52 above.

As to claim 54, this claim is a system claim corresponding to the method claim 52 respectively, and is rejected for the same reasons set forth in the rejection of claim 52 above.

As to claim 56, Johnson further teaches the act (D) further comprises retrieving the source file (*see [0040]*).

As to claim 57, Johnson further teaches the file other than the source file is a web page (*see [0040]*).

As to claim 59, Burakoff further teaches the act (B) further comprises storing the indication of the source location in electronic file storage (*see column 3, lines 20-33*).

As to claims 61, 62, and 64, these claims are computer-readable medium claims corresponding to the method claims 56, 57, and 59 respectively, and are rejected for the same reasons set forth in the rejection of claims 56, 57, and 59 above.

As to claims 66, 67, and 69, these claims are system claims corresponding to the method claims 56, 57, and 59 respectively, and are rejected for the same reasons set forth in the rejection of claims 56, 57, and 59 above.

7. Claims 70-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burakoff et al (US 6,122,635) in view of Johnson (US 2002/0107847 A1) and further in view of Carnahan et al (US 7,212,996 B1).

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As to claim 70, note the discussion of claim 1 above, Burakoff and Johnson disclose all of the elements of claim 1 but fail to explicitly recite the source file is an item of compliance information.

However, Carnahan teaches the source file is an item of compliance information (*see column 1, lines 13-38 and column 4, lines 12-25*).

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Burakoff, Johnson, and Carnahan before him or her, to modify the teachings of Burakoff and Johnson to include the search corpus of mutual funds of Johnson for the purpose of developing a search engine capable of returning a mutual fund web sites (*see column 1, lines 13-38*).

Therefore, it would have been obvious to combine Carnahan with Burakoff and Johnson to obtain the invention as specified in the instant claims.

As to claim 71, Carnahan further teaches the item of compliance information is a prospectus for a mutual fund (*see column 1, lines 13-38 and column 4, lines 12-25*).

As to claims 72 and 73, these claims are computer-readable medium claims corresponding to the method claims 70 and 71 respectively, and are rejected for the same reasons set forth in the rejection of claims 70 and 71 above.

As to claims 74 and 75, these claims are system claims corresponding to the method claims 70 and 71 respectively, and are rejected for the same reasons set forth in the rejection of claims 70 and 71 above.

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Response to Arguments

8. Applicant's arguments with respect to claims 1, 3-12, 18, 20-29, 35, 37-46, 52-54, 56, 57, 59, 61, 62, 64, 66, 67, and 69-75 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JARED M. BIBBEE whose telephone number is (571)270-1054. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. S./

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/J. M. B./

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/Apu M Mofiz/

Supervisory Patent Examiner, Art Unit 2161